

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC. and
TELEFONAKTIEBOLAGET LM ERICSSON,
Petitioner,

v.

INTELLECTUAL VENTURES I LLC,
Patent Owner.

Case IPR2014-01149
Patent 6,023,783

Before JOSIAH C. COCKS, WILLIAM A. CAPP, and
DAVID C. MCKONE, *Administrative Patent Judges*.

CAPP, *Administrative Patent Judge*.

DECISION

*Authorizing Opposition Briefing
to Petitioner's Unopposed Motion to Withdraw
Challenged Claims 55–59*

37 C.F.R. §§ 42.5, 42.22, 42.23

The instant matter before the Board relates to an extended sequence of procedural requests initiated by Petitioner, Ericsson Inc. and Telefonaktiebolaget LM Ericsson (collectively “Ericsson”), commencing with a Motion to Correct Petition and Motion to Modify Decision to Institute (Paper 27, “Motion to Correct Petition”), filed April 30, 2015. After considering briefs filed by both parties, we denied Ericsson’s Motion to Correct Petition by Order entered May 19, 2015. (Paper 31).

Subsequently, on May 29, 2015, Ericsson unilaterally and without prior authorization from the Board, filed a paper captioned “Petitioner’s Notice of Withdrawal of Challenged Claims 55–59.” (Paper 32, the “Notice to Withdraw”). We treated Ericsson’s Notice to Withdraw as an unauthorized motion and, pursuant to our authority under 37 C.F.R. § 42.7(a), entered an Order directing that the Notice to Withdraw be expunged from the record. Paper 34.

After that, Ericsson requested a teleconference with the Board and sought leave to file a motion to withdraw its challenge to claims 55–59 in this IPR proceeding. *See* Paper 36. A teleconference was held on June 23, 2015, attended by both parties, to consider Ericsson’s request. *Id.* At the teleconference, Patent Owner Intellectual Ventures I LLC (“Intellectual Ventures”) indicated that it did not oppose Ericsson withdrawing its challenge to claims 55–59 in this IPR proceeding and indicated that it waived any right to file an opposition. *Id.* On June 24, 2015, we entered an Order authorizing Ericsson to file its requested motion and, in the Order, we directed Ericsson to explain where the Board derives the authority to withdraw claims once trial has been instituted in an IPR proceeding. *Id.*

Pursuant to our Order of June 24, 2015 (Paper 36), Ericsson filed its Petitioners' Unopposed Motion to Withdraw Challenged Claims 55–59 on August 20, 2015. (Paper 52, the “Unopposed Motion”). Thereafter, on August 24, 2015, counsel for Intellectual Ventures contacted the Board and, in essence, notified us that the scope of relief requested in Ericsson's Unopposed Motion differed from the extent of relief which Intellectual Ventures previously did not oppose. At that time, Intellectual Ventures requested leave to file an opposition to Ericsson's Unopposed Motion.

On August 26, 2015, this IPR proceeding came before the Board for regularly scheduled oral argument hearing on the merits of Ericsson's IPR Petition. At the conclusion of the hearing, the panel entertained comments and argument from counsel concerning the extent to which Ericsson's Unopposed Motion is, indeed, unopposed.

After considering the foregoing events and hearing the comments and arguments of counsel, we will authorize Intellectual Ventures to file an opposition to Ericsson's Unopposed Motion and will, furthermore, authorize Ericsson to file a reply to such opposition in accordance with the schedule detailed below.

ORDER

It is hereby

ORDERED, that Intellectual Ventures is authorized to file an opposition of no more than 15 pages to Ericsson's Unopposed Motion on or before September 30, 2015.

ORDERED, that Ericsson is authorized to file a reply of no more than 5 pages to Intellectual Venture's opposition on or before October 30, 2015.

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